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09/287,023	04/06/1999	DALE W. MALIK	BS100/176677	5759

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EXAMINER

NGUYEN, DUC MINH

ART UNIT

PAPER NUMBER

2643

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/287,023

Applicant(s)

MALIK

Examiner

Duc Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-7, 10-12, 14-23, 26-27, 29, 32-33, 34-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Lesley (6,333,976).

Consider claims 1-3, 10, 12, 34. Lesley teaches a method for using a communication to conduct a transaction with respect to a telecommunications account, comprising receiving the communication at the service switching point, the communication being associated with a CLID (subscriber's home residence telephone number; col. 6, ln. 48-50); causing the SSP to route the

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communication to the intelligent network element (SCP 20; col. 6, ln. 8-34); causing the intelligent network element to obtain a telecommunications account number (prepaid account) and a transaction amount from the communication, the account number corresponding to the telecommunications account with respect to which transaction is to be conducted in the billing system (the abstract, ln. 22-31; fig. 4a-b, steps 99, 100, 102, 98; col. 6, ln. 46 to col. 7, ln. 36); in response to obtaining the telecommunications account number and the transaction amount, causing the intelligent network element to provide the telecommunications account number, the transaction amount, and the calling line number associated with the communication to the service control point (fig. 3; col. 9, ln. 34 to col. 10, ln. 25); in response to receipt of the telecommunications account number, the transaction amount, and the calling line number, causing the SCP to make an assignment of the telecommunications account number, the transaction amount, and the calling line number to a billing message (fig. 3; col. 7, ln. 37-63; col. 9, ln. 5-9; col. 10, ln. 13-25); and causing the billing system (40) to retrieve the billing message from the SCP, to note the assignment of the telecommunications account number, the transaction amount, and the calling line number to the billing message, and based on the assignment, to conduct the transaction in the billing system with respect to the telecommunications account associated with the telecommunications account number by crediting or debiting the telecommunications account by at least the transaction amount (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25).

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Consider claims 4-5, 15, 17. Lesley further teaches causing the SCP to carry out a validation whose result comprises a determination that the calling line number is authorized with respect to conduct of the transaction (col. 7, ln. 1-28).

Consider claims 6, 16. Fig 2, col. 6, ln. 59-67 read on the limitations of claims 6, 16.

Consider claims 7, 14. Col. 10, ln. 13-25 reads on the limitations of claims 7, 14.

Consider claim 11. The special access code is met by the 1-800 number (col. 5, ln. 38-54).

Consider claims 18-23. Lesley teaches a method to conduct a transaction with respect to a telecommunications account (pre-paid account; col. 7, ln. 1-36) in the system, comprising obtaining a billing message generated as a result of a telecommunications service performed with respect to a calling line number (subscriber's home telephone number; col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25); in response to obtaining of the billing message, the billing system (40) inherently makes a determination that the billing message includes an indication that a transaction is to be conducted with respect to a telecommunications account in the system (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25); and in response to the determination, the billing system (40) inherently conducts the transaction with respect to the telecommunications account (col. 7, ln. 37-63; col. 9, ln. 5-33; fig. 3; col. 10, ln. 13-25).

Consider claims 26-27, 29. Lesley teaches a method for execution of a transaction in the billing system between the calling line number account (col. 9, ln. 10-33) and one of the other accounts (prepaid account) to which the billing system has access, comprising providing that the

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billing message includes an indication for the execution of the transaction (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25), causing the billing system to make a recognition of the indication in the billing message (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25); and in response to the indication in the billing message, inherently causing the billing system to execute the transaction between the calling line number account and the one of the other accounts (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25).

Consider claims 32-33. Col. 9, ln. 29-33 reads on the limitations of claims 32-33.

Consider claim 35. Lesley teaches a method for executing a transaction, comprising receiving a communication associated with a calling line number (col. 9, ln. 10-33); obtaining a transaction amount from the communication (e.g., adding a pre-pay value to subscriber account; col. 9, ln. 10-33); coding the transaction amount and the calling line number into a billing message (fig. 3; col. 7, ln. 37-63; col. 9, ln. 5-9; col. 10, ln. 13-25); posting the billing message (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25); obtaining the billing message, and decoding the transaction amount and the calling line number from the billing message (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25); and crediting or debiting an account associated with the calling line number by the transaction amount (col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25).

Consider claim 36. Lesley teaches a system for allowing a user to initiate a transaction and have the transaction conducted, comprising a service switching point (SSP 28) for receiving a communication from a user, and for obtaining and acting on instructions regarding the communication (see fig. 5); a service control point (SCP 20) for providing the instructions

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regarding the communication to the SSP, the instructions instructing the SSP to retrieve transaction information and to forward the transaction information to the SCP, for including the transaction information in a billing message by assigning the transaction information to at least a field of the billing message, and for posting the billing message for retrieval by a billing system (see fig. 5; col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25); and the billing system (40) for retrieving the billing message (see fig. 3; col. 7, ln. 37-63; col. 9, ln. 5-9; col. 10, ln. 13-25), for inherently recognizing the transaction information in the billing message, and based on the recognition, for inherently conducting the transaction based on the transaction information (see fig. 5; col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25).

Consider claim 37. Fig. 3; col. 7, ln. 37-63; col. 9, ln. 5-9; fig. 3; col. 10, ln. 13-25 read on the limitations of claim 37.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13, 24-25, 28, 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lesley (6,333,976) in view of Resnick et al (6,185,545).

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Consider claims 13, 28. Lesley does not teach charging a fee for the transaction.

Resnick teaches charging a fee for the transaction (col. 5, ln. 32-58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Resnick into the teachings of Lesley, so that the telecommunications network can recoup expenses and earn some profits from providing services to the users.

Consider claims 24-25, 30-31. Lesley combines the invoice relates to the transaction conducted with respect to the telecommunications account (i.e., prepay account) and the invoice for the different telecommunications account (subscriber's home telephone number account) (col. 9, ln. 5-9). Furthermore, the mere fact that a given structure is integral does not preclude its consisting of various elements, Nerwin v. Erlichman, 168 USPQ 177, 179 (PTO Bd. of Int. 1969). There is also a requirement that the unification or integration involve more than just mere mechanical skill. In re Murray, 19 C.C.P.A. (Patents) 739, 53 F.2d 541, 11 USPQ 155; In re Zabel et al., 38 C.C.P.A. (patents) 832, 186 F.2d 735, 88 USPQ 367. It appears that the unity or diversity of parts would depend more upon the choice of the manufacturer, and the convenience and availability of the machines and tools necessary to construct the telecommunication test system, than on any inventive concept.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Nguyen whose telephone number is (703) 308-7527.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Kuntz, can be reached on (703) 305-4708.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-6306 or (703) 308-6296 (Group's Fax numbers)
(703) 746-7251 (Examiner's Fax number, only for proposed amendment)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

May 15, 2002



DUC NGUYEN
PRIMARY EXAMINER